

### REMARKS

This application has been carefully reviewed in light of the Office Action dated July 30, 2007. Claims 1, 2, 5 to 8, 10 to 21, 25, 28 to 31, 33 to 44, 51, 52, 101, 102, 106, 112 and 113 are pending in the application. Claims 1, 2, 25, 51 and 52 are the independent claims herein. Reconsideration and further examination are respectfully requested.

Applicant wishes to thank the Examiner for the courtesies and thoughtful treatment accorded Applicant's undersigned representative during the October 25, 2007 telephonic interview. This amendment has been prepared in accordance with the discussions and agreements reached during that interview and it is submitted that the following accurately reflects those discussions and agreements.

In the Office Action, Claims 1, 2, 5 to 8, 10 to 21, 28 to 31, 33 to 44, 51, 52, 101, 102, 106, 112 and 113 were rejected under 35 U.S.C. § 112, first paragraph. The Office Action indicated that the language "which the destination device is able to process" be removed from the claims, and that the claims not be amended to read "which the destination device is **most likely** able to process", which is in accordance with the specification. Without conceding the correctness of the rejections, the language in question has nonetheless been deleted from the claims. However, it is respectfully submitted the term "a predetermined standard image format" as now recited in the claims corresponds to the baseline image format as described in the specification. The baseline format is one that, as those skilled in the art would readily understand, corresponds to the formats recites

in, for example, Claim 10. As agreed during the interview, the amendments overcome the § 112, first paragraph rejections.

Claims 1, 2, 5 to 8, 10 to 21, 28 to 31, 33 to 44, 51, 52, 101, 102, 106, 112 and 113 were also rejected under 35 U.S.C. § 112, second paragraph. Again, the terminology in question has been amended and as agreed during the interview, the amendments overcome the rejections.

Thus, reconsideration and withdrawal of all of the § 112 rejections are respectfully requested.

Claims 1, 2, 5 to 8, 10 to 21, 25, 28 to 31, 33 to 44, 5, 52, 101, 102, 106, 112 and 113 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,023,345 (Bloomfield) in view of U.S. Patent No. 6,157,706 (Rachelson) and further in view of U.S. Patent No. 6,020,980 (Freeman). During the interview, no agreement was reached as to whether or not the amended claims would be allowable over the art of record. However, Applicant submits that the amended claims are allowable for at least the following reasons.

As recited in the amended claims, the invention relates to the transmission of electronic mail with image data attached. However, in order to better ensure that the image data is converted into a format that can be processed by the receiving (destination) device, the invention applies a three-step conversion process. In the invention, a destination address for is designated for a destination device of the e-mail. The invention first looks up the destination address in a database to attempt to determine an appropriate format for the image data corresponding to the destination device. If the destination device is found and the format is in the database, then the invention converts the image data

according to the format stored in the database and transmits the e-mail with the converted image data. If, however, the destination device and its format are not stored in the database, then the invention employs a second technique for converting the image data.

Specifically, if the format of the image data for the destination device is determined to not be stored in the database, the invention attempts to obtain the format of the image data via functional information of the destination device. The invention initiates a communication with the destination device to obtain functional information of the format of the image data for the destination device. If the functional information for the format of the image data is obtained from the destination device, even though the format was not stored in the database, then the invention converts the image data into the format of the image data based on the obtained functional information. Thus, this second procedure provides an additional step for better ensuring that the image data is properly converted before transmission. However, if the functional information is not obtained in the communication, and the format is not included in the database, then the invention employs a third conversion technique to convert the image data into a predetermined standard image format (i.e., one of the more commonly used formats in the industry).

Referring specifically to the amended claims, Claim 1 is directed to a communication apparatus for transmitting electronic mail data by connecting to the Internet, the apparatus comprising designation means for designating a destination address for transmission of the electronic mail, determination means for determining a format of image data in correspondence with the designated destination address by referring to a database for storing functional information of destination devices, in a case where

transmission of the electronic mail data with the image data attached thereto is performed, communication means for, before the transmission of the electronic mail data is performed, and in a case where the determination means determines that the functional information of the format of the image data for the destination device corresponding to the designated destination address is not stored in the database, initiating communication with a destination device corresponding to the designated destination address to obtain functional information of the format of the image data for the destination device, converting means for i) converting the image data into the format determined by said determination means in a case where the functional information of the format of the image data for the destination device corresponding to the designated destination address is stored in the database, ii) in a case where the determination means determines that the functional information of the format of the image data for the destination device corresponding to the designated destination address is not stored in the database and where said communication means obtains the functional information of the format of the image data in the communication initiated with the destination device, converting the image data into the format of the image data based on the functional information obtained from the destination device by said communication means, and iii) in a case where the determination means determines that the functional information of the format of the image data for the destination device corresponding to the destination address is not stored in the database, and where said communication means does not obtain the functional information of the format of the image data in the communication initiated with the destination device, converting the image data into a predetermined standard image format, and transmission means for

transmitting the electronic mail data with the image data which is converted by said converting means to the destination device corresponding to the designated destination address.

Amended independent Claim 2 includes features substantially corresponding to Claim 1, but is more specifically directed to a communication apparatus comprising designation means for designating a destination address for transmission of electronic mail, first connecting means for connecting to a local area network and second connecting means for connecting to a wide area network, first communicating means for communicating electronic mail data by connecting to the Internet by one of said first and second connecting means, second communicating means for performing facsimile communication by connecting to the wide area network by said second connecting means, determination means for determining a format of image data in correspondence with the designated destination address by referring to a database for storing functional information of destination devices, in a case where transmission of the electronic mail data with the image data attached thereto is performed, control means for controlling said first communication means so as to, before the transmission of the electronic mail data is performed, and in a case where the determination means determines that the functional information of the format of the image data for a destination device corresponding to the designated destination address is not stored in the database, initiating communication with the destination device corresponding to the designated destination address to obtain functional information of the format of the image data for the destination device, converting means for i) converting the image data into the format determined by said

determination means in a case where the functional information of the format of the image data for the destination device corresponding to the designated destination address is stored in the database, ii) in a case where the determination means determines that the functional information of the format of the image data for the destination device corresponding to the designated destination address is not stored in the database and where said first communication means obtains the functional information of the format of the image data in the communication initiated with the destination device, converting the image data into the format of the image data for the destination device based on the functional information obtained from the destination device by said first communication means, and iii) in a case where the determination means determines that the functional information of the format of the image data for the destination device corresponding to the destination address is not stored in the database and where said first communication means does not obtain the function information of the format of the image data in the communication initiated with the destination device, converting the image data into a predetermined standard image format, and transmission means for transmitting the electronic mail data with the image data which is converted by said converting means to the destination device corresponding to the designated destination address.

Claim 25 is a computer medium claim that corresponds to Claim 2, while Claims 51 and 52 are method and system claims, respectively, that correspond to Claim 1.

The applied art, alone or in any permissible combination, is not seen to disclose or to suggest the features of Claims 1, 2, 25, 51 and 52, and in particular, is not seen to disclose or to suggest at least the features of 1) in a case where a determination

means/step determines that functional information of the format of image data for a destination device corresponding to a designated destination address is not stored in a database and where a (first) communication means obtains functional information of the format of the image data in a communication initiated with the destination device, converting the image data (to be transmitted as attached to electronic mail data) into the format of the image data for the destination device based on the functional information obtained from the destination device by the (first) communication means, or 2) in a case where the determination means/step determines that the functional information of the format of the image data for the destination device corresponding to the destination address is not stored in the database and where the (first) communication means does not obtain the function information of the format of the image data in the communication initiated with the destination device, converting the image data into a predetermined standard image format.

Bloomfield is merely seen to teach a system in which a fax server converts fax image data into a standard TIFF format that can be displayed by e-mail readers and browsers. As admitted in the Office Action, Bloomfield fails to teach the claimed communication means that obtains functional information from the destination device, and the converting means/step that utilizes conversion procedure ii) of the claims (i.e., conversion based on the obtained functional information).

Rachelson is not seen to overcome the deficiencies of Bloomfield. In this regard, assuming *arguendo* that Rachelson's teachings could be applied to Bloomfield, Rachelson merely teaches an e-mail system in which user's register their preferences, such

as the image format that images are to be converted into. When an e-mail is received, the recipient's address is obtained from a header and their preferences are looked up for conversion of the image. If the user has not used the system before, the image is merely converted into TIF format. (see column 11, lines 5 to 29). Thus, while Rachelson may add the feature of determining whether the recipient's format is included in the database, Rachelson nonetheless lacks the same features that are lacking in Bloomfield; namely, initiating a communication with the destination device to obtain the functional information if the format is not stored in the database, and then i) converting the image data according to the obtained functional information if it is obtained in the communication, and ii) only then converting the image data into the standard format if the functional information is not obtained and the format is not included in the database.

Freeman also lacks the foregoing features of the invention. In this regard, Freeman is seen to disclose a fax-email subscriber service in which subscribers can select a format for receiving images. Thus, Freeman is much like Rachelson in which the subscriber's preferences are obtained and the image is converted accordingly. However, Freeman, like Bloomfield and Rachelson, lacks the features of initiating a communication with the destination device to obtain the functional information if the format is not stored in the database, and then i) converting the image data according to the obtained functional information if it is obtained in the communication, and ii) only then converting the image data into the standard format if the functional information is not obtained and the format is not included in the database.



Thus, even if Bloomfield, Rachelson and Freeman could have been combined, such a combination still would not have resulted in the present invention. Accordingly, Claims 1, 2, 25, 51 and 52, as well as the claims dependent therefrom, are believed to be allowable.

As a formal matter, Applicant again requests that the Examiner provide an indication acknowledging Applicant's claim to priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents. Applicant previously submitted a request for the priority claim acknowledgment on November 5, 2003, but to date, none of the actions in this case have included the requested acknowledgment. Accordingly, the Examiner is requested to include the requested acknowledgment in the next communication.

No other matters having been raised, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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